

REMARKS

In the present Amendment, claims 1-2 and 4-7 have been amended to be directed to a process for forming an image-receiving sheet for electrophotography. Claim 1 is amended such that a toner-image-receiving layer is formed with a prescribed self-dispersing water-dispersible polyester resin emulsion. Section 112 support for the amendment reciting a process for forming an image-receiving sheet, as opposed to an image-receiving sheet *per se*, may be found, for example, in the working Examples beginning at page 89 of the present specification, which describe and illustrate a process for forming an image-receiving sheet for electrophotography in accordance with the present invention.

Upon entry of the Amendment, which is respectfully requested, claims 1-2, 4-7 and 10-25 will be pending, with claims 10-25 being withdrawn from consideration.

In Paragraph No. 3 of the Action, claims 1, 2 and 4-7 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-6 of U.S. Patent No. 6,720,064.

Applicants respectfully traverse.

The presently claimed process for forming an image-receiving sheet for electrophotography is not merely an obvious variant of the image-receiving sheet for electrophotography claimed in Goto '064. A first difference between the presently claimed invention and Goto is that the present claims relate to a process for forming an image-receiving sheet for electrophotography, whereas Goto relates to an image-receiving sheet *per se*. A second difference between the presently claimed process and the sheet of Goto is that the sheet of the

presently claimed process includes a support. The Examiner asserts that Goto's claimed sheet is "deemed to have a support," but does not point out where this is disclosed or suggested in the claims.

Even if Goto's sheet could be inferred to include a support, a third difference is that there is nothing in Goto's claims which discloses or suggests that the support (if there is one) includes a resin layer disposed on at least one side of a base.

A fourth difference is that there is nothing in Goto which discloses or suggests that the resin layer arranged between the toner-image-receiving layer and the base contains at least one polyethylene resin, let alone a polyethylene having a mass average density of 0.935 g/cm^3 or less.

A fifth difference is that there is nothing in the claims of Goto '064 which discloses or suggests that the resin layer arranged between the toner-image-receiving layer and the base contains at least one polyethylene resin having a melt flow rate (MFR) of 11 g/10 min. or less.

A sixth difference is that there is nothing in the claims of Goto '064 which discloses or suggests that the toner-image-receiving layer contains a thermoplastic resin in the form of a self-dispersing water-dispersible polyester resin emulsion which satisfies the properties (1) to (4) recited in claim 1.

For at least these reasons, the rejection is without merit.

An additional reason the rejection lacks merit is that the Examiner improperly relies on the specification of Goto to support the rejection, which is improper in the context of an obviousness-type double patenting rejection

For these reasons, the Examiner is respectfully requested to reconsider and withdraw the obviousness-type double patenting rejection of claims 1, 2 and 4-7 based on claims 1-6 of Goto '064.

In Paragraph No. 4 of the Action, claims 1, 2 and 4-7 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 7 and 8 of U.S. Patent No. 6,936,395.

The Examiner's characterization of the Goto et al. '395 patent and his reasoning in support of the rejection are the same as in Paragraph No. 4 of the previous Office Action.

The Examiner responds to Applicants' arguments in Paragraph No. 9, at page 8 of the Action.

Per the Examiner, Applicants argue (similarly to the preceding rejection) that Goto et al. '395 fails to recite that the support thereof includes a polyethylene resin having the claimed MFR. Furthermore, Applicants have argued, Table 1 of Goto et al. was improperly relied upon for the contention that the image receiving sheet disclosed in claims 1, 7 and 8 of Goto et al. has a support containing polyethylene.

The Examiner states that these arguments are unpersuasive "because the specification can be used as a dictionary for generically claimed support sheet and Table 1 clearly shows claimed support."

The rejection has no merit. Applicants respectfully traverse.

Contrary to what the Examiner contends, he is not using the specification as a “dictionary.” He is improperly relying upon it to read recitations into the claims of Goto et al. which are not there.

A first difference between the claims of Goto et al. and the present claims is that Goto et al. pertains to an electrophotographic image receiving sheet *per se*, whereas the present claims are directed to a process for forming an image-receiving sheet for electrophotography.

A second difference between the claims of Goto et al. and the present claims is that Goto et al. does not disclose or suggest that its support includes a resin layer disposed on at least one side of a base.

A third difference is that Goto et al. does not disclose or suggest that this resin layer (arranged between the toner image receiving layer and the base) contains at least one polyethylene resin having a mass-average density of 0.935 g/cm³ or less.

Yet another difference is that Goto et al. does not disclose or suggest in its claims that this intermediate resin layer (between the toner-image-receiving layer and the base) must contain at least one polyethylene resin having a melt flow rate (MFR) of 11 g/10 min. or less.

Based on these distinctions, Applicants respectfully request reconsideration and withdrawal of the obviousness-type double patenting rejection based on claims 1, 7 and 8 of Goto et al. '395.

In Paragraph No. 5 of the Action, claims 1, 2 and 4-7 are rejected under 35 U.S.C. § 102(f) on the ground that the Applicants did not invent the claimed subject matter.

The Examiner's characterization of Goto '064 and his reasoning in support of the rejection are the same as in Paragraph No. 6 of the previous Office Action.

Applicants respectfully traverse.

Section 102(f) provides that a person shall be entitled to a patent unless he did not himself invent the subject matter sought to be patented.

Here, the Examiner has not presented any evidence that the present Applicants, that is, Yoshisada Nakamura and Yoshio Tani, did not invent the subject matter that they are claiming in the present patent application. That would be the only basis for a rejection under §102(f), and here, the Examiner has totally failed to provide any support for the rejection.

Applicants respectfully request reconsideration and withdrawal of the rejection for the above reasons.

In Paragraph No. 6 of the Action, claims 1, 2 and 4-7 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Goto (U.S. Patent 6,720,064).

Applicants submit that this rejection should be withdrawn because Goto '064 does not disclose or render obvious the process for forming an image-receiving sheet for electrophotography of the present invention.

In this regard, the Examiner has not shown that the Kao Corporation polyester resin TUFTONE U-5 employed in Example 1 as shown in Table 2 at col. 22 of Goto '064 is a self-dispersible polyester resin emulsion satisfying the conditions (1) to (4) recited in present claim 1. It is noted that while Kao Corporation polyester resin TUFTONE U-5 is mentioned at page 27, line 14 of the present specification as a resin (i) having an ester bond, this description precedes

that portion of the present specification which states that the thermoplastic resin for use in the present invention is preferably a self-dispersible polyester resin emulsion satisfying conditions (1) to (4). See the description beginning in the paragraph bridging pages 33 and 34 of the present application.

In view of the above, the Examiner is kindly requested to reconsider and withdraw the § 102(e) anticipation rejection of claims 1, 2 and 4-7 based on Goto '064.

In Paragraph No. 7 of the Action, claims 1, 2 and 4-7 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ashida et al. (U.S. Patent 5,824,462) in view of Ogino et al. (U.S. Patent Application Publication 2002/0037176 A10), Takehana et al. (U.S. Patent 5,885,698) and Ikeuchi et al. (U.S. Patent 6,444,383 B2).

Applicants submit that this rejection should be withdrawn because Ashida et al., Ogino et al., Takehana et al. and Ikeuchi et al. do not disclose or render obvious the process for forming an image-receiving sheet for electrophotography as recited in the present claims.

Ashida '462 is deficient in that it fails to teach a water-dispersible polyester resin emulsion which satisfies properties (1) to (4) as recited in Claim 1. Ogino '176, Takehana '698, and Ikeuchi '383 are relied upon to make up for this deficiency in Ashida '462.

Claim 1 recites that the glass transition temperature is 40° C to 100° C.

In contrast, Ogino '176 teaches a polyester resin having a glass transition temperature Tg of about "30° C or less, preferably 15° C." *See*, paragraph [0122]. In this regard, Ogino '176 fails to make up for the deficiency in Ashida '462.

The mixture of NE382-1 and GK130 as disclosed in Ogino '176 would not necessarily provide for a glass transition temperature is 40° C to 100° C. Ogino '176 discloses that this mixture is an example of the polyester resin that has a glass transition temperature T_g of about 30° C or less, preferably 15° C. As such, Ogino '176 fails to make up for the deficiency in Ashida '462.

Furthermore, Claim 1 recites that the volume average particle diameter is 20 nm to 200 nm.

In contrast, Ogino '176 fails to teach the volume average particle diameter of its polyester resin. In this regard, it appears that Ogino '176 fails to teach or suggest that its polyester resin has a volume average particle diameter from 20 nm to 200 nm.

Takehana '698 teaches that its image-receiving layers 12 and 22 may include a polyester. *See*, col. 6, lines 24-29. Takehana '698 fails to teach the volume average particle diameter of its polyester. As such, it appears that Takehana '698 fails to teach or suggest that its polyester has a volume average particle diameter from 20 nm to 200 nm. As a result, Takehana '698 fails to make up for the deficiency in Ashida '462.

Ikeuchi '383 teaches that a polyester is used in the receptor layer of its image receiving sheet. *See*, col. 7, lines 26-28. Ikeuchi '383 fails to teach or suggest that the polyester thereof has a volume average particle diameter from 20 nm to 200 nm. As such, Ikeuchi '383 fails to make up for the deficiency in Ashida '462.

In response to Applicants' arguments, the Examiner contends that these arguments are unpersuasive "because the final image receiving layer does not have polyester resin in the

particulate form.” It is not clear upon what the Examiner bases this assertion. Further, even if it were true that the final image receiving layer does not have polyester resin in the particulate form, the present claims as amended are directed to a process for forming an image-receiving sheet for electrophotography. The references relied upon by the Examiner do not disclose or suggest the use in a process for forming an image-receiving sheet of a self-dispersing water-dispersible polyester resin emulsion having a volume average particle diameter of 20 nm to 200 nm, let alone the other properties required for the polyester resin emulsion employed in the present invention. The present claims are patentable over Ashida et al., Ogino, et al., Takehana et al. and Ikeuchi et al, where, as here, the claimed subject matter can only be arrived at through a piecemeal hindsight reconstruction of the invention. These documents do not disclose, suggest or fairly render obvious the presently claimed process for forming an image-receiving sheet for electrophotography.

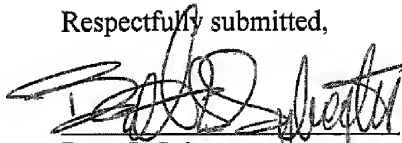
For these reasons, the Examiner is respectfully requested to reconsider and withdraw the § 103 rejection of claims 1, 2 and 4-7 based on Ashida et al. ‘462 in view of Ogino et al. ‘176, Takehana et al. ‘698 and Ikeuchi et al. ‘383.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.114 (c)
U.S. Appln. No.: 10/663,841

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

Brett S. Sylvester
Registration No. 32,765

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

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